

REMARKS

The Official Action of April 14, 2009, and the newly applied prior art have been carefully reviewed. The claims in the application remain as claims 1, 4, 6 and 8-28, and these claims define patentable subject matter warranting their allowance. Favorable reconsideration and allowance are earnestly solicited.

Claim 20 is amended above, and is the only claim amended. The form of claim 20 has been changed to the Jepson form to emphasize that the forgery preventing film of claim 1 is a component of the claimed material, but the scope of claim 20 has not been changed.

Claims 1, 4, 6 and 8-28 have been rejected under §102 as anticipated by Takahashi et al USP 6,013,363 (Takahashi) which is directed to a packaging material. This rejection is respectfully traversed.

Applicants do not at present dispute that Takahashi discloses a microporous thermoplastic resin film comprising thermoplastic resin films provided on both sides of a core layer where a black solid print layer having a thickness of 1 micrometer to 5 micrometers is formed on the back of the microporous resin film by offset or gravure printing to form

an opacifying layer which comprises the thermoplastic resin films. Nevertheless, applicants respectfully traverse the rejection and dispute that Takahashi anticipates claim 1 and the claims which depend therefrom which incorporate the subject matter of claim 1.

Thus, the rejection states at page 3 that the claimed light shielding layer formed on the back of the thermoplastic microporous resin film of Takahashi is a light shielding layer having a dot ratio of from 5 to 70 percent, a total light transmittance through the light part of the shaded area of from 5 to 12 percent and the proportion of the dark part of the shaded as being at least 90 percent and that the light part is at most 10 percent. Applicants disagree.

Takahashi does not and cannot disclose the claimed dot ratio, the claimed total light transmittance through the light part of the shaded area, the claimed proportion of the dark part of the shaded area, and the claimed proportion of the light part of the shaded area. It is not clear to applicants why and how the examiner understands that the black solid part layer of Takahashi has the claimed properties.

Contrary to the examiner's understanding, Takahashi indicates that the black solid print layer has a very low or zero transmittance. Please refer to column 8, lines 54 to 56 of Takahashi, which states:

When the thickness of each layer is too thin to sufficiently shade light, a black solid print layer having a thickness of from 1  $\mu\text{m}$  to 5  $\mu\text{m}$  is formed on the back of the stretched microporous resin film base layer (I) by offset or gravure printing to form an opacifying layer, or a primer adhesive containing a large amount (5% to 75% by weight) of a white filler such as titanium oxide whiskers or fine titanium oxide particles is applied in an amount of from 2  $\text{g}/\text{m}^2$  to 10  $\text{g}/\text{m}^2$  as the primer layer for adhering the stretched microporous resin film base layer (I) to the gas barrier resin film layer (II) to form an opacifying layer, thereby reducing the total light beam transmittance of the packaging material to 0%.(emphasis added)

Takahashi thus explicitly states that the black solid print layer is formed to reduce the total light beam transmittance to 0%. It is clear that the product of Takahashi does not satisfy the claimed condition, "the total light transmittance through the light part of the shaded area is from 5 to 12 percent".

A major object of Takahashi is to protect products packaged within the Takahashi packaging material from being degraded by outside influences, and the first and third paragraphs of column 1 of Takahashi mention products such as tea, bath salts, coffee beans, drugs, agricultural chemicals, candies and fertilizer, among which materials are those which are degraded by light. Takahashi then mentions at column 8, commencing at line 47 that for such products as coffee beans, high-grade green tea, etc., "the total light beam

transmittance... of the [Takahashi] packaging materials is required to be 0%."

Thus, to the extent that "shading" has any meaning in Takahashi at all, it is that the shading must be total. In other words, in those cases where the black solid print layer of Takahashi has shading capability, the transmittal of light (the transmittance) is 0%, and Takahashi does not satisfy the recitation in claim 1 of being "invisible by reflected light but visible by transmitting light." In any case where the light part of the black solid print layer had a dot ratio from 5 to 70 percent, it has no technical significance with regard to forgery prevention since the transmittance of the Takahashi product is 0%.

Accordingly, Takahashi does not anticipate claim 1 and of course does not anticipate any of the claims which depend from and incorporate the subject matter of claim 1. Applicants accordingly request withdrawal of the rejection.

Applicants also respectfully dispute what is set forth in the bottom paragraph on page 3 of the Official Action, which relies on alleged inherency. The law is clear that the PTO may not rely on alleged inherency unless inherency is "reasonably certain", e. g. *Ex parte Levy*, 17 USPQ2d 1461, 1463-64 (BPAI 1990). There is absolutely no

reasonable certainty of inherency in the present case, as already pointed out above.

Applicants should briefly mention that they further disagree with the conclusion set forth in the Office Action that the claim 1 preamble reciting "forgery-preventing" coupled with the recitation in the body of the claim that both faces of the light-shielding layer are "processed for forgery prevention" merely recites an intended use. To the contrary, that language defines what the product is, and this is not what the Takahashi packaging material is. *In re Bullock et al*, 203 USPQ 171, 174 (CCPA 1979); *Corning v Sumitomo*, 9 USPQ 2d 1962, 1965-66 (Fed.Cir. 1989).

Lastly, applicants wish to briefly address the rejection of claims 21-28. Takahashi discloses a packaging material, not a card, not a security, not a certificate, not a bill, not a ticket, not a check, not a license, not a label. Takahashi not only does not disclose the products specifically called for in claims 21-28, but also gives not the remotest hint that the packaging material of Takahashi would be useful in the manufacture of any such products or materials.

Applicants believe that all issues raised in the Official Action have been addressed above in a manner that should lead to patentability of the present application.

Appln. No. 10/758,595  
Amendment dated July 14, 2009  
Reply to Office Action dated March 14, 2009

Favorable reconsideration and allowance are respectfully  
requested.

Respectfully submitted,

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